

ASCI BLUE INTELLECTUAL PROPERTY

The following is the text of Department of Energy Memorandum regarding Intellectual Property Rights for the ASCI Blue procurement:

"If the respondent to the RFP does not agree to cost-share at least 20% excluding waived fee, that respondent if successful would get the standard patent and data causes in connection with such a procurement. On the other hand, if the respondent is willing to cost-share by an amount of at least 20% excluding waived fee, the DOE will agree to waive, in advance, patent rights to the respondent in its inventions and authorize the respondent to assert copyright in software produced under the contract subject to the following requirements:

1. With respect to Patent Rights, a standard DOE Patent Rights Clause including the waiver will contain the following provisions:

A. Any waived rights to inventions will be subject to a reserved government-use license as follows: "The government shall have a nonexclusive, nontransferable, irrevocable, paid-up license to practice or have practiced for or on behalf of the United States any subject invention throughout the world".

B. The government will have march-in rights to any subject inventions consistent with the march-in rights set out in 35 USC 203 and 48 C.F.R. 27,304-1(g).

C. That the recipient of such rights agree to submit, upon the request of DOE, a non-proprietary report no more frequently than annually on efforts to utilize any technology arising under the contract.

D. Any assignment of invention rights is subject to DOE approval.

E. That the recipient agree to the following United States Competitiveness provision:

U.S. Competitiveness Provision

"The waiver recipient agrees that any products embodying any waived invention or produced through the use of any waived invention will be manufactured substantially in the United States, unless the waiver recipient can show to the satisfaction of DOE that it is not commercially feasible to do so. Processes, services, and improvements thereof which are covered by any waived invention developed under this contract shall be incorporated into the contractor's manufacturing facilities in the United States either prior to or simultaneously with implementation outside the United States, shall not result in reduction of the use of the same processes, services, or improvements in the United States. The waiver recipient further agrees to make the above conditions binding on any assignee or licensee or any entity otherwise acquiring rights to any waived invention, including subsequent assignees or licensees."

F. U.S. Preference per 35 USC 204 will apply.

2. With respect to copyrights of computer software, the standard DOE rights in Technical Data Article as set out in Acquisition Letter 87-5 would be modified as follows: Paragraph (c) would be replaced with the following:

"(c) Copyright. (1) Data first produced in the performance of this contract, unless provided otherwise in paragraph (d) of this clause, the Contractor may establish, without prior approval of the Contracting Officer, claim to copyright subsisting in scientific and technical articles based on or containing data first produced in the performance of this contract and published in academic, technical or professional journals, symposia proceedings or similar works. The prior, express written permission of the Contracting Officer is required to established claim to copyright subsisting in all other data first produced in the performance of this contract. When claim to copyright is made, the Contractor shall affix the applicable copyright notices of 17 USC 401 or 402 and acknowledgment of Government sponsorship (including contract number) to the data when such data are delivered to the Government, as well as when the data are published or deposited for registration as a published work in the U. S. Copyright Office. For data other than computer software the Contractor grants to the Government, and others acting on its behalf, a paid-up, nonexclusive, irrevocable worldwide license in such copyrighted data to reproduce, prepare derivative works, distribute copies to the public, and perform publicly and display publicly, by or on behalf of the Government.

The Contractor may establish, without prior approval of the Contracting Officer, claim to copyright subsisting in computer software first produced in the performance of this contract. For computer software, the Contractor grants to the Government and others acting in its behalf, a paid-up nonexclusive, irrevocable worldwide license in such copyrighted computer software to reproduce, prepare derivative works, and perform publicly and display publicly by or on behalf of the Government. Contractor will provide the DOE an abstract suitable for publication, describing the function of the software for which copyright is asserted.

This limited Government license will revert to a broad Government license (where the Government has the right to distribute the software to the public and permit others to do so) after five (5) years if the Contractor has not taken effective steps to commercialize the software; or where it is necessary to alleviate health, safety or energy needs that are not reasonably satisfied by the Contractor, or to meet requirements for public use specified by Federal Regulations and these requirements are not reasonably satisfied by the Contractor."

Paragraph (d)(3) would be modified by eliminating the first two sentences and retaining the last sentence as follows:

"The Contractor shall promptly deliver to the Contracting Officer or to the Patent Counsel designated by the Contracting Officer a duly executed and approved instrument fully confirmatory of all rights to which the Government is entitled and other terms pertaining to the computer software to which claim to copyright is made.

The justification for the above will be fully set out in the Statement of Considerations for the subject patent waiver."